

REMARKS

Applicant has canceled claim 1 and rewritten it as new claim 14. Claim 2 has been amended and claim 3 has been canceled. Claims 4, 5, 7 and 9 have been amended to make them dependent upon claim 14. Claims 10 – 13 have been canceled and new claims 14 – 18 have been added.

These amendments are not the addition of new matter nor do they raise new issues. Accordingly, Applicant respectfully asks the Examiner to enter the amendments.

Applicant respectfully traverses the rejection of claims 1 – 5, 7 and 9 – 13 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

Applicant respectfully submits that claims 2, 4 – 5, 7, 9 and 14 – 18 now comply with this requirement. The specification now provides enablement for what is claimed. See page 6, lines 4 – 9; page 9, lines 9 – 19 and page 11, lines 22 – 31 of the specification.

Accordingly, Applicant respectfully asks that the Examiner withdraw the rejection under 35 U.S.C. §112.

Applicant respectfully traverses the rejections of claim 1 – 5, 9 under 35 U.S.C. §103(a) over U.S. Patent No. 5,646,076 to Bortz.

Claims 2, 4 – 5, 7, 9 and 14 – 18 patentably distinguish over Bortz in the

recitation of the fibrous base material comprising about 75% to about 85%, by weight, fibers and about 15% to about 25%, by weight, fillers based on the weight of the fibrous base material, wherein the fibrous base material has an average voids volume from about 50% to about 85%.

Bortz is silent about the amount of fiber used. Bortz does not disclose the amount of filler claimed. Bortz does not disclose the void volume claimed.

Bortz fails to disclose or suggest what Applicant claims. The mere existence of these 3 elements is not even found in the reference. The Examiner cannot add to Bortz where is not there.

Without Applicant's specification for a road map, one would not reach the claimed combination. Clearly, the prior art has no appreciation for the high fibrous content Applicants claim.

The Examiner also asks for a showing of unexpected results with the claimed amounts. Applicant respectfully submits that Bortz is so deficient that such a showing is not required.

The Examiner also states that the proportions appear to be within the ordinary level of skill of one in the art. Applicant respectfully submits that this conclusion is unsupported in fact or theory. No prior art discloses the high fiber contents Applicant claim. No reference has been cited showing the high fiber contents. One cannot add facts to a reference. No such fact exists in Bortz.

Accordingly, Applicant respectfully asks that the Examiner withdraw the rejection under 35 U.S.C. §103.

Applicant respectfully traverses the rejection of claims 7 and 10 – 13 under 35 U.S.C. §103(a) over U.S. Patent No. 5,646,076 to Bortz and further in view of U.S. Patent 5,707,905 to Lam et al.

Claims 2, 4 – 5, 7, 9 and 14 – 18 patentably distinguish over Bortz in the recitation of the fibrous base material, wherein the fibrous base material has an average voids volume from about 50% to about 85%.

The deficiencies of Bortz have been pointed out and will not be repeated herein.

Further, Applicant respectfully submits that the friction materials in Bortz are complete products that have been designed to provide specific performance characteristics and that it is not possible to add or replace components in the material without entirely reengineering the structure of the material. In addition, there is no teaching or suggestion in either of these references that the complete material product that has been designed to achieve specific results can or should be modified.

Still further, Lam et al. do not supply the deficiencies of Bortz. Nowhere does either reference disclose or suggest the high fiber contents Applicant claims.

Applicant respectfully submits that one cannot rely on hindsight in reaching

an obvious determination. It is essential that the decision maker forget what he or she has been taught by the claimed invention. See In re Fine, 837 F.2d 1071, 5 USPQ 1596 (CAFC 1988). The Examiner's rejection ignores the express limitations in the claims. See Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc. 796 F.2d 443, 448-449, 230 USPQ 416, 420 (Fed.Cir. 1986).

Accordingly, Applicant respectfully asks that the Examiner withdraw this rejection under 35 U.S.C. §103.

In response to the provisional rejection of claims 1, 3, 7, 9 and 10 on the ground of nonstatutory obviousness-type double patenting over claims 10, 11, 12, 14 and 15 of copending Applicant No. 10/678,720 Applicant submits herewith a Terminal Disclaimer obviating that rejection. Accordingly, Applicants respectfully ask that the Examiner withdraw this rejection.

In response to the provisional rejection of claims 1 and 10 on the ground of nonstatutory obviousness-type double patenting over claims 9 and 21 of U.S. Patent 6,630,416, Applicant submits herewith a Terminal Disclaimer obviating that rejection. Accordingly, Applicant respectfully submits herewith a Terminal Disclaimer obviating that rejection. Accordingly, Applicant respectfully asks that the Examiner withdraw this rejection.

Therefore, Applicant respectfully submits that claims 2, 4 – 5, 7, 9 and 14 – 18 as amended are in condition for allowance and respectfully ask that the

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Examiner pass the claims to issue.

Respectfully submitted,

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